

Appl. No. 10/612,197
Docket No. AA537C
Amdt. dated November 7, 2008
Reply to Office Action mailed on August 7, 2008
Customer No. 27752

REMARKS

Claim Status

Claims 1-5 and 10-14 are pending in the present application. No additional claims fee is believed to be due.

Rejection Under 35 USC §103(a) Over Lassen (U.S. Pat. No. 4,631,062)

Claims 1-5 and 10-14 have been rejected under 35 USC §103(a) as being obvious in view of Lassen, U.S. Patent No. 4,631,062. This rejection is respectfully traversed.

Applicant respectfully submits that the Office Action has failed to set forth a *prima facie* case of obviousness in accordance with M.P.E.P. 2143. Specifically, the Office Action has failed to show where Lassen teaches or suggests each and every element of Claims 1-5 and 10-12, such as, *e.g.*, an absorbent interlabial device that is configured such that the entire absorbent interlabial device resides within the interlabial space of a wearer during use, the absorbent interlabial device having the claimed dimensions.

The Office Action argues that although “Lassen does not disclose the specific dimensions of the pad,” the device of Lassen is “capable of being fitted within an interlabial region of a user, particularly if the device is folded” and that “how an article will fit on a user is relative to the size of a user” and further that “the fact that Lassen teaches a larger pad that resides outside of the interlabial space is a matter of function rather than structure.” Therefore, the Office Action argues that “one having ordinary skill in the art would be able through routine experimentation to determine the appropriate size of the interlabial pad in accordance with the intended use.” (Office Action, pages 3-4).

In response, Applicant agrees with the Office Action’s statements that Lassen does not disclose the specific claimed dimensions and that Lassen teaches a larger pad that resides outside of the interlabial space. Applicant respectfully submits, however, that it is not clear how one skilled in the art would be able to determine the appropriate size of the interlabial pad in accordance with the intended use, as argued by the Office Action. Is the appropriate size the size of the larger pad that resides outside of the interlabial space shown in Lassen or is the appropriate size the size of the smaller pad claimed by

Applicant that is configured such that the entire absorbent interlabial device resides within an interlabial space? In addition, assuming that the device of Lassen can even be folded small enough to fit within the interlabial space of a user as argued by the Office Action (Applicant notes that the Office Action has not provided any evidence that this is indeed the case or that a user would even be motivated to fold the device in this manner), the Office Action does not specify why one skilled in the art would then be motivated to reduce the size of the Lassen device to provide a smaller pad as claimed by Applicant, or, for that matter, how the folded Lassen device would meet other limitations of the claim.

Applicant respectfully submits that the claimed invention is not merely a change in dimension of the interlabial device of Lassen. Applicant notes that “[t]he size of [Applicant’s] interlabial device 20 is important to its comfort and effectiveness.” Specification, page 6, line 1. For example, Applicant teaches:

Once the interlabial device 20 is inserted into the interlabial space, the body contacting surface 22 of the convex portion 26 preferably adheres to the skin of the interlabial space, more preferably to the inside surfaces of the labia minora. When the wearer W is standing, the labial walls tend to close the concave portion 28 of the interlabial device 20.

The interlabial device 20 is preferably at least partially retained in place by exerting a slight laterally outwardly-oriented pressure on the inner surfaces of the wearer’s labia minora, labia majora, or both. The body fluids discharged is absorbed by the absorbent member 30 of the convex portion 26. Additionally, the interlabial device 20 may also be held by attraction of naturally moist labial surfaces to the material of the body contacting surface 22.

Page 7, line 30, through page 8, line 5, and Figure 6. As such, Applicant’s claimed invention does not merely involve a change in the dimensions of the labial pad. Instead, the claimed invention relates to an interlabial device with specific and different dimensions to result in differences in function compared to the device of Lassen.

The Board of Patent Appeals and Interferences and the CAFC have repeatedly stated that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Ex parte Blank*, Appeal No. 2008-3819 (BPAI, Sept. 4, 2008) and *Ex parte Mardian*, Appeal No. 2008-2369

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(BPAI, June 5, 2008), citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) *quoted with approval in KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 1741 (2007).

For example, in *Ex parte Mardian*, the BPAI found that the Examiner had not presented sufficient factual findings and reasoning to establish a prima facie case of obviousness when the prior art reference did not describe two different inlet sizes and the Examiner “merely concludes that ‘[i]t would have been obvious to one of ordinary skill in the art... to optimize the dimension of... [the] inlets.’” (*Mardian*, page 10). Specifically, the Board stated the following:

The deficiency of the Examiner’s obviousness conclusion is that claim 7 does not merely set forth a change in the dimension of the purge gas inlets. The claim language sets forth a specific geometric relationship of two different sizes of inlets relative to the chamber outlet in order to achieve a specific result (namely, a greater volumetric flow of purge gas further from the chamber outlet than closer thereto, Spec. 8:15-214). We note that of the cases relied upon by the Examiner, *In re Rose*, 220 F.2d 459 (CCPA 1955) and *In re Rinehart*, 531 F.2d 1048 (CCPA 1976) involved mere scaling up of prior art sizes; whereas *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed. Cir. 1984) involved a situation wherein the evidence showed that the claimed dimensional limitations did not perform any differently than the prior art. The situation before us does not involve “mere scaling up” of the prior art, nor is there any evidence nor rationale provided by the Examiner that the claimed dimensional relationship would not perform any differently than the prior art device. We therefore must agree with Appellants that no support for the Examiner’s conclusory statement is found in the applied prior art or otherwise (Br. 16).

(*Id.* at page 11).

Similarly, in *Ex parte Blank*, the BPAI concluded that the Examiner failed to “clearly articulate any reason why an artisan would have made such a modification to [the prior art].” (at page 7). The Board again focused on the fact that the claimed invention did not merely set forth a change in dimension. For example, at pages 6-7, the Board states:

The deficiency of the Examiner’s obviousness conclusion is that claim 1 (as well as claim 24) does not merely set forth a change in the dimension of the adhesive free zones. The claim language sets forth a specific geometric relationship of at least two different sizes/lengths of adhesive free zones relative to the adhesive patches in order to achieve a specific

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result (namely, a label roll capable of being printed upon such that the adhesive free zones correspond in longitudinal spacing with the longitudinal spacing of various feedpath components, *see*, e.g., Spec. 8:26-30). We note that of the cases discussed in MPEP 2144.04 relating to changes in size/proportion (as implicitly relied upon by the Examiner), *In re Rose*, 220 F.2d 459 (CCPA 1955) and *In re Rinehart*, 531 F.2d 1048 (CCPA 1976) involved mere scaling up of prior art sizes; whereas *Gardner v. TEC Sys., Inc.*, 725 F. 2d 1338, 1345-46 (Fed. Cir. 1984) involved mere changes in the dimensions of the parts of a claimed dryer as compared to those of a prior art dryer for the same function wherein the evidence showed that the claimed dimensions would not result in the claimed device performing any differently than the dryer of the prior art. The situation before us does not involve “mere scaling up” of the prior art, nor is there any evidence rationale provided by the Examiner that the claimed nondimensional relationship would not necessarily result in differences in performance over the prior art product.

As in *Ex parte Mardian* and *Ex parte Blank*, Applicant has not merely claimed a change in dimensions from the pad of Lassen, but has instead claimed a labial device that functions differently and in an improved manner from the device of Lassen.

Accordingly, Applicant respectfully submits that the Office Action has failed to make a *prima facie* case of obviousness in accordance with M.P.E.P. 2143. As such, Applicant respectfully requests that the rejection be withdrawn and that Claims 1-5 and 10-12 be allowed.

Conclusion

In view of the foregoing, reconsideration of this application and allowance of the pending claim(s) are respectfully requested.

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Respectfully submitted,

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